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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/497,176 02/03/00 ARDAUD

P 022701-863

EXAMINER

021839 IM52/0808
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ART UNIT	PAPER NUMBER

1711
DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/497,176

Applicant(s)
Ardaud et al.

Examiner
Rabon Sergeant

Group Art Unit
1711



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-50 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-50 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5,6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1, 11, 22, 25, 37, and 48, the use of "high" and "low" renders the claims indefinite, because the language is subjective.

It is questioned if the dependencies of claims 38 and 48 are correct.

Within claims 11, 25, 30, and 37, applicants have referred to a component as being solid or non-solid; however, applicants have failed to specify the conditions under which the physical states exist. In the absence of the physical conditions, it is not clear to what extent the conditions can be considered as being definitive limitations.

2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since claim 1 fails to refer to powder forms or particle sizes, it is unclear how the particle size of claim 12 is to relate to claim 1.

3. Claims 15, 16, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the isocyanates of claims 15 and 41 are mutually exclusive from the isocyanates of claims 1 and 25. The isocyanates should be clearly distinguished from each other.

Art Unit: 1711

4. Claims 2 and 25-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 2 and 25, it is unclear what value is denoted by the numerical quantity of 30 mg KOH/g. Is the value an acid number? Also, within claim 2, no basis has been provided for tin II percent content.

5. Contrary to the information provided within the Information Disclosure Statement of December 20, 2000, an English abstract has not been provided for DE 3332463.

6. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 43 fails to further limit the subject matter of claim 25.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reference within claim 2 regarding carboxylic acid is confusing, since claim 1 fails to suggest such a component.

8. Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for high gloss yielding compositions which contain the features disclosed within lines 2-26 of page 4 of the specification, does not reasonably provide enablement for

Art Unit: 1711

coating composition intended to yield high gloss finishes which lack one or more of the aforementioned features. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The examiner has considered applicants's disclosure, and the position is taken that applicants have failed to provide adequate enablement for the production of viable high gloss yielding compositions when the composition is not governed by all of the features disclosed within page 4. For example, claim 25 lacks language pertaining to the degree of liberation with respect to the masking agent and claim 1 lacks language pertaining to the glass transition temperature of the isocyanate and the conditions specified at lines 15-26 of page 4.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

Sergent/sp

July 23, 2001